

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

REMARKS

Applicants would like to thank the Examiner for the thorough examination of the present application. The arguments supporting patentability of the claims are provided below.

I. The Claimed Invention

The present invention, as recited in independent Claim 1, for example, is directed to a method for distributing a public information release authorization (PIRA) form over an intranet. The method comprises creating and submitting a PIRA form over the intranet, with the PIRA form being submitted by an author to at least one approver via e-mail with a hyperlink to the PIRA form. Comments for the PIRA form are transmitted by the at least one approver via e-mail.

Independent Claim 13 is directed to an intranet for distributing a PIRA form, and is similar to independent Claim 1.

Independent Claim 25 is directed to a computer-readable medium having computer-executable instructions, and is also similar to independent Claim 1.

II. The Claims are Patentability Distinct From Co-Pending Application 09/596,629

The Examiner has taken the position that the claims in co-pending application 09/596,629 are not patentability distinct from each other because the claims in the present application are directed towards the same process of disseminating information. The Examiner further states that even though the claims are directed to different types of information, the distinction is

In re Patent Application of:

CHAPMAN ET AL.

Serial No. 10/617,065

Filing Date: JULY 10, 2003

irrelevant because the technical details of the present invention are independent of the type of data being transmitted and the particular human sender and receivers of data.

As correctly noted by the Examiner, since the claims are directed to different types of information, there is clearly a distinction therebetween. For instance, the claims in the co-pending application are directed to invention disclosures, whereas the claims in the present invention are directed to a public information release authorization (PIRA) form.

In the co-pending application, independent Claim is as follows:

1. (co-pending application) A method for distributing an invention disclosure over an intranet, the method comprising the steps of:
 - accessing an invention disclosure template form over the intranet;
 - creating an invention disclosure using the invention disclosure template form, the invention disclosure being created by an inventor and including information about an invention;
 - selecting an option in the invention disclosure template form to include an attachment with the invention disclosure;
 - attaching a file to the invention

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

disclosure without the use of a hyperlink,
the file being created by the inventor
separate from the invention disclosure and
including information about the invention
that is not included in the invention
disclosure;

submitting the invention disclosure
along with the attached file over the
intranet to at least one evaluator via e-
mail with a hyperlink to the invention
disclosure; and

transmitting evaluation comments
on the invention disclosure and the attached
file by the at least one evaluator via e-
mail.

As recited in the claim, an invention disclosure is
first created using an invention disclosure template form, with
the invention disclosure being created by an inventor and
including information about an invention. An attachment can be
selected as an option in the invention disclosure template form.
A file is attached to the invention disclosure without the use of
a hyperlink, with the file being created by the inventor separate
from the invention disclosure and including information about the
invention that is not included in the invention disclosure.

In the present application, independent Claim 1 is as
follows:

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

1. (present application) A method for distributing a public information release authorization (PIRA) form over an intranet, the method comprising:

creating and submitting a PIRA form over the intranet, the PIRA form being submitted by an author to at least one approver via e-mail with a hyperlink to the PIRA form; and

transmitting comments for the PIRA form by the at least one approver via e-mail.

In the present application, the PIRA form is created and submitted by an author. In sharp contrast, the invention disclosure in the co-pending application is first created using an invention disclosure template form, with the invention disclosure being created by an inventor and including information about an invention. In the present application, there are no attachments. In sharp contrast, each of the independent claims in the co-pending application requires selecting an attachment as an option in the invention disclosure template form.

The Applicants submit that based on the above noted distinctions between the claims in the present application and the claims in the co-pending application, the claims are patentability distinct from one another. Moreover, since the claims (in the co-pending and present applications) are directed to different types of information, different and additional steps are recited in the co-pending application. In the co-pending

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

application, the invention disclosure is first created using an invention disclosure template form, and the invention disclosure template form allows the user to select "attachment" as an option for attaching a file to the invention disclosure without the use of a hyperlink. The Applicants submit that the claims are patentably distinct in view of the above noted distinctions: the difference in how the invention disclosure form is first created and in which includes an attachment, and in attaching the file without the use of a hyperlink.

The Applicants further submit that if a double patenting rejection is to be maintained by the Examiner, then a nonobviousness-type double patenting rejection is proper, which can be overcome by the filing of a terminal disclaimer.

III. The Specification Supports The Computer-Readable Medium Claims

The Examiner objected to the specification based on the position that the specification does not provide proper antecedent basis for the claims directed to a computer-readable medium. MPEP §608.01(o) states the following:

"The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import;"
(Emphasis added).

The terms recited in Claims 25-36 are very similar to the terms used in original Claims 1-12. The detailed description

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

in the Applicants' specification is enabling for creating and submitting a PIRA form, and for transmitting comments for the PIRA form as recited in independent Claim 1.

To provide a direct correlation between the language recited in the computer-readable medium claims and what is listed in the application, the Applicants' have amended the specification accordingly. The Applicants submit that no new matter is being added since the original language in independent Claims 1 is fully supported by the specification.

The Examiner also noted that the Applicants do not provide a description of what a computer readable medium comprises. The Applicants respectfully submit that one skilled in the art readily understands that a computer-readable medium comprises computer-readable instructions for causing a user computer to perform certain steps. Accordingly, one skilled in the art readily understands that the computer-readable instructions can be stored on a number of different types of computer readable mediums. The Applicants submit that Claims 25-36 are supported by the application in view of those skilled in the art.

IV. The Spencer Patent Is Not A Prior Art Reference

The Examiner has taken the position that the provisional applications 60/141,306 and 60/146,254 do not provide written description support for the claimed subject matter because there is no reference at all to the claimed "public information release authorization forms."

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

In the '306 provisional application, reference is directed to page 18, lines 14-16, which provides: "The technical paper is included as an attachment to the technical paper form filled out by the author." (Emphasis added). As discussed in the '306 provisional, the technical paper form is web-based, and the various fields in the form are filled out by the author. Once various fields have been filled out, e-mail notification messages with hyperlinks to the form are used as part of the approval process.

The Applicants used the term "public information release authorization form" in the claimed invention instead of "technical paper form" since it is more generic. For example, reference is also directed to page 17, lines 16-21, which provides: "The technical paper approval process is used to approve the external and internal release of technical papers, abstracts, presentations, reports, journal articles, books, and other information intended for publication or presentation outside of a particular corporation." (Emphasis added).

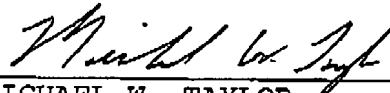
The Applicants submit that the '306 provisional application provides written description support for the claimed "public information release authorization form" since there is reference to a "technical paper form" and "external release" for "publication or presentation outside of a particular corporation." Since the priority date of the Spencer patent is after the priority date of the '306 provisional application, Spencer should be removed as prior art.

In re Patent Application of:
CHAPMAN ET AL.
Serial No. 10/617,065
Filing Date: JULY 10, 2003

IV. CONCLUSION

In view of the arguments provided herein, it is submitted that all the claims are patentable. Accordingly, a Notice of Allowance is requested in due course. Should any minor informalities need to be addressed, the Examiner is encouraged to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,



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CERTIFICATE OF FACSIMILE TRANSMISSION

I HEREBY CERTIFY that the foregoing correspondence has been forwarded via facsimile number 571-273-8300 to the Commissioner for Patents on this 31 day of October, 2007.

